



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/604,541	06/27/2000	Marco A. DeMello	MSFT-0184/154568	5019

7590

03/19/2004

Peter M Ullman
Woodcock Washburn Kurtz MacKiewicz & Norris LLP
One Liberty Place
46th Floor
Philadelphia, PA 19103

EXAMINER

ZAND, KAMBIZ

ART UNIT	PAPER NUMBER
----------	--------------

2132

DATE MAILED: 03/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/604,541

Applicant(s)

DEMELLO ET AL.

Examiner

Kambiz Zand

Art Unit

2132

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 and 32-44 is/are rejected.
- 7) ☒ Claim(s) 31 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4,5 and 7. 6) ☐ Other: _____

DETAILED ACTION

1. **Claims 1-44** have been examined.

Information Disclosure Statement PTO-1449

2. The pages of the all references submitted by applicant have been considered.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. **Claim 10** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase "first limit" makes the claim unclear. Examiner considers the first limit as a time period in which the certificate is valid.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. **Claims 1-7, 9-12, 14-24, 26-30 and 32-44** are rejected under 35 U.S.C. 102(e) as being anticipated by Tarpenning et al (Nuvomedia Inc (WO 00 21239 A) recited in the IDS, paper number 7 by Applicant.

As per claims 1, 2 and 11 Tarpenning et al (Nuvomedia Inc (WO 00 21239 A) disclose computer-readable medium having computer-executable instructions and a method of enabling the use of a first digital work on plural computing devices (fig.1 where digital data 6 and 3 are used between devices), said method comprising the acts of: receiving from a first computing device, a user's credentials; authenticating said credentials by querying a namespace authority (see page 4, lines 17-23); providing a first activation certificate to said first computing device (see page4, line 23-30); and persisting an association between said credentials and at least some information included in said first activation certificate (see page 5, lines 1-6). Also see page 5, lines 1-6 and 11-24 where the authentication server or other certificate authority is considered as a second computing device and where a new certificate such as a second certificate is activated based on the sequence number of the user certificate by adding the value after

revocation of the original certificate that relates to the credential information of the user as originally presented in the previous claims as part of first certificate and the persisted information such as pk/pv keys or electronic ids as outlined in line 3 of page 8.

As per claim 3 Tarpenning et al (Nuvomedia Inc (WO 00 21239 A) teach the method of claim 1, wherein said first activation certificate comprises first data indicative of said user (see page 4, lines 28-29 where the generated certificate is indicative of a user).

As per claims 4 Tarpenning et al (Nuvomedia Inc (WO 00 21239 A) teach the method of claim 1, wherein said first activation certificate comprises a first cryptographic key (see page 4, lines 31-32 where the certificate contains multiple pk/pv keys where one of those pair may be considered as the first cryptographic key), and wherein said first digital work comprises at least some data requiring said first cryptographic key for its use (see page 4, lines 31-32 where the content is a digital work that requires such data as a pk/pv key for decryption use).

As per claims 5 Tarpenning et al (Nuvomedia Inc (WO 00 21239 A) teach the method of claim 4, wherein at least some information persistently associated with said credential comprises said first cryptographic key (see page 4, lines 28-29 where the generated certificate is indicative of a user and page 4, lines 31-32 where the certificate contains multiple pk/pv keys where one of those pair may be considered as the first cryptographic key).

Art Unit: 2132

As per claims 6 Tarpenning et al (Nuvomedia Inc (WO 00 21239 A) teach the method of claim 4, wherein said digital work comprises encrypted content and decryption key which decrypts said encrypted content (see page 4, lines 31-32), said decryption key being included in said first digital work in an encrypted or sealed from decryptable or unsealable by said first cryptographic key (see page 4, lines 23-27 where the encrypted key being decrypted by the first key such as device private/public key).

As per claims 7 Tarpenning et al (Nuvomedia Inc (WO 00 21239 A) teach the method of claim 5, wherein said first activation certificate further comprises a second cryptographic key, wherein said first and second cryptographic keys are the private and public keys respectively, of an asymmetric key pair, and wherein said decryption key is included in said first digital work in a form encrypted by said second cryptographic key (see page 4, lines 17-33 where each pair of pk/pv key is considered as first, second, etc pair keys and where they are considered as asymmetric keys).

As per claims 9 Tarpenning et al (Nuvomedia Inc (WO 00 21239 A) teach the method of claim 1, further comprising the acts of: Receiving, from a second computing device, said credentials; accessing the persisted information associated with said credentials; providing, to said second computing device, a second activation certificate based at least in part on the persisted information (see page 5, lines 16-24 where the authentication server or other certificate authority is considered as a second computing

Art Unit: 2132

device and where a new certificate such as a second certificate is activated that relates to the credential information of the user as originally presented in the previous claims as part of first certificate and the persisted information such as pk/pv keys or electronic ids as outlined in line 3 of page 8).

As per claims 10 Tarpenning et al (Nuvomedia Inc (WO 00 21239 A) teach the method of claim 1, further comprising the acts of: Receiving, from a second computing device, said credentials; determining whether a first limit has been reached, and if said first limit has not been reached, providing to said second computing device a second activation certificate based at least in part on the persisted information associated with said credentials (see page 5, lines 11-24 where the authentication server or other certificate authority is considered as a second computing device and where a new certificate such as a second certificate is activated based on the sequence number of the user certificate by adding the value after revocation of the original certificate that relates to the credential information of the user as originally presented in the previous claims as part of first certificate and the persisted information such as pk/pv keys or electronic ids as outlined in line 3 of page 8).

As per claims 12, 21 ,38, 39, 42 and 44 Tarpenning et al (Nuvomedia Inc (WO 00 21239 A) teach computer-readable medium, a method of using, a digital work on plural computing devices, said method comprising the acts of: on a first computing device, transmitting credentials to an activation arrangement; receiving, from said activation

arrangement, a first activation certificate comprising a first cryptographic key; on a second computing device, transmitting said credentials to said activation arrangement; and receiving, from said activation arrangement, a second activation certificate comprising said first cryptographic key; wherein said digital work requires said first cryptographic key for its proper use (see page 5, lines 1-6 and 11-24 where the authentication server or other certificate authority is considered as a second computing device and where a new certificate such as a second certificate is activated based on the sequence number of the user certificate by adding the value after revocation of the original certificate that relates to the credential information of the user as originally presented in the previous claims as part of first certificate and the persisted information such as pk/pv keys or electronic ids as outlined in line 3 of page 8; fig.1 where digital data 6 and 3 are used between devices; see page 4, lines 17-30).

As per claims 14 Tarpenning et al (Nuvomedia Inc (WO 00 21239 A) teach the method of claim 12, further comprising the act of authenticating said credentials (see page 4, lines 12-21).

As per claims 15 Tarpenning et al (Nuvomedia Inc (WO 00 21239 A) teach the method of claim 12, wherein said first cryptographic key is included in said first activation certificate in a first form, and wherein said first cryptographic key is included in said second activation certificate in a second form different from said first form (see page 4, lines 17-33; page 5, lines 1-6 where first certificate is generated such as first form; page

Art Unit: 2132

5, lines 16-20 where the new generated certificate has a second form such a new sequence number that is different from the first form that has different sequence number).

As per claims 16 Tarpenning et al (Nuvomedia Inc (WO 00 21239 A) teach the method of claim 12, wherein said activation arrangement comprises one or more server computing devices (see fig.1 where many server are present).

As per claims 17 Tarpenning et al (Nuvomedia Inc (WO 00 21239 A) teach the method of claim 12, wherein said digital work comprises encrypted content and a second cryptographic key which decrypts said encrypted content, said second cryptographic key being included in said digital work in an encrypted form decryptable by said first cryptographic key (see page 4, lines 23-32 where the encrypted key being decrypted by the first or second key such as device private/public key).

As per claims 18 Tarpenning et al (Nuvomedia Inc (WO 00 21239 A) teach the method of claim 12, further comprising the acts of transmitting, to a content provider, at least some information included in said first activation certificate; and receiving, from said content provider, said digital work (see abstract).

As per claims 19 and 41 Tarpenning et al (Nuvomedia Inc (WO 00 21239 A) teach the method of claim 12 and 39, wherein said first activation certificate is at least partly

Art Unit: 2132

resistant to being used on a computing device other than said first computing device, and wherein said second activation certificate is at least partly resistant to being used on a computing device other than said second computing device (see page 4-5 where each device has its own pv/pk keys and therefore the certification activation of one is not decryptable by a device that such certificate has not been encrypted by its key and therefore resistant to be used on other device that the one it is assigned to).

As per claims 20 Tarpenning et al (Nuvomedia Inc (WO 00 21239 A) teach the method of claim 12, wherein each of said first and second activation certificates includes information indicative of said credentials (see page 4).

As per claims 22 Tarpenning et al (Nuvomedia Inc (WO 00 21239 A) teach the method of claim 21, wherein said item comprises digital content, and wherein use of said item comprises rendering said digital content (see page 6, lines 22-25).

As per claims 23 Tarpenning et al (Nuvomedia Inc (WO 00 21239 A) teach the method of claim 22, wherein said digital content comprises textual content (see page 6, lines 22-25), and wherein use of said item comprises displaying said textual content on a viewing device (see fig.1, item 110 or 115).

As per claims 24 and 43 Tarpenning et al (Nuvomedia Inc (WO 00 21239 A) teach the method of claims 22 and 39, wherein said digital content comprises multimedia content

Art Unit: 2132

(see page 6, lines 22-25), and wherein use of said item comprises rendering said multimedia content on a device adapted to render said multimedia content (see fig.1 where all the devices has capability of rendering multimedia content).

As per claims 27 Tarpenning et al (Nuvomedia Inc (WO 00 21239 A) teach the method of claim 21, wherein said first data differs in at least some respect from said second data (see page 6, lines 22-25 where the data may be a text or graphic that is different from the first data).

As per claims 28-30 Tarpenning et al (Nuvomedia Inc (WO 00 21239 A) teach the method of claim 27-29, wherein said first data comprises a first cryptographic key which enables the use of said item, said first cryptographic key being included in said first data in a form encrypted by a second cryptographic key (see page 4, lines 23-32 where the encrypted key being decrypted by the first or second key such as device private/public key), and wherein said second data comprises said first cryptographic key in a form encrypted by a third cryptographic key different from said second cryptographic key (see page 4-14 for same analogy than the first part where each device has its own pair key called first, second, third and fourth key that are private and public keys of the devices transmitting and receiving the content digital data).

Art Unit: 2132

As per claims 32 Tarpenning et al (Nuvomedia Inc (WO 00 21239 A) teach the method of claim 27, further comprising the act of persisting an association between said persona and at least some of said first data (see page 4-5).

As per claims 33 Tarpenning et al (Nuvomedia Inc (WO 00 21239 A) teach the method of claim 21, wherein said item does not reside on said first computing device at the time said first data is provided to said first computing device (see page 4-6).

As per claims 34 Tarpenning et al (Nuvomedia Inc (WO 00 21239 A) teach the method of claim 33, wherein said item is created subsequent to the acts of providing said first and second data to said first and second computing devices respectively (see page 4-8).

As per claims 35 Tarpenning et al (Nuvomedia Inc (WO 00 21239 A) teach the method of claim 21, further comprising the act of determining the number of computing devices on which use of said item is enabled (see page 4, line 33 and page 5, line 1-2).

As per claims 36 Tarpenning et al (Nuvomedia Inc (WO 00 21239 A) teach the method of claim 21, further comprising the act of determining, prior to providing said second data to said second computing device, the amount of time that has elapsed since use of said item was enabled on said first computing device (see page 11, lines 28-33).

Art Unit: 2132

As per claims 37 Tarpenning et al (Nuvomedia Inc (WO 00 21239 A) teach the method of claim 21, wherein said first and second data each include information indicative of said persona (see page 4-6).

As per claim 40 Tarpenning et al (Nuvomedia Inc (WO 00 21239 A) teach the method of claim 39, wherein said first information is based on or identifies at least some hardware associated with said remote computing device (see page 4-5 where information is based on identity of a device).

Also see page 4-14 for detailed description with respect to the above claims.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims **8, 13 and 25-26** are rejected under 35 U.S.C. 103(a) as being unpatentable over Tarpenning et al (Nuvomedia Inc (WO 00 21239 A).

Art Unit: 2132

As per claims 8, 13 and 25-26 Tarpenning et al (Nuvomedia Inc (WO 00 21239 A) teach the method of claims 1 and 12, wherein said credential comprise an electronic id's (see page 8, line 3 and page 11, line 30) but do not mention that the ids are username and a password. However Chapman et al (5,774,650 A) disclose having a password and username as user ids as a logon procedure. It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize Chapman et al (5,774,650 A)'s password + user name for the credential of Tarpenning in order to verify an entity and permission access level to the network .

Also see page 4-14 for detailed description with respect to the above claims.

Allowable Subject Matter

9. Claim 31 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

U.S. Patent No. US (6,088,717 A) teach computer based communication system and method using metadata defining a control structure.

11. In view of the papers filed 11/14/02, it has been found that this nonprovisional application, as filed, through error and without deceptive intent, improperly set forth the inventorship, and accordingly, this application has been corrected in compliance with 37 CFR 1.48(a). The inventorship of this application has been changed by 11/14/2002.

Therefore the petition to correct inventorship in compliance with 37 CFR 1.84(a) has been granted.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kambiz Zand whose telephone number is (703) 306-4169. The examiner can normally be reached on Monday-Thursday (8:00-5:00). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on (703) 305-1830. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private

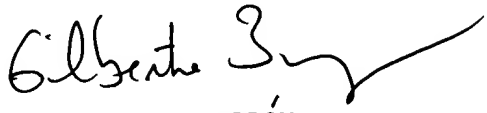
Art Unit: 2132

PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197

(toll-free).


Kambiz Zand

03/08/04


GILBERTO BARRÓN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100